

REMARKS / ARGUMENTS

Claims 1-33 are pending in the instant application. Claims 1-30 were previously presented, claims 31-33 are new claims. Claims 6, 16 and 26 are cancelled, and have been rewritten as new claims 31-33 in independent form. Claims 1, 11 and 21 have been amended to clarify the claim language. The Applicant points out that the amendments are supported in at least Figs. 2 to 10, and related descriptions. Claims 1, 11 and 21 are independent claims. Claims 2-10 and 31, 12-20 and 32, and 22-30 depend directly or indirectly from claims 1, 11 and 21 respectively.

Claims 1, 11 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by the Applicant's background section or admitted prior art ("APA").

Claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-30 stand rejected under 35 U.S.C. §103(a) based on "APA" in view of USPN 5,923,663 ("Bontemps").

Claims 6, 16 and 26 are objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. Examiner's Response to Arguments

At page 8 of the Final Office Action, the Examiner argues that the Applicant's Fig. 1 (i.e., Applicant's admitted prior art or "APA") reads on "determining any one usable media pair from all existing media pairs of a first device," in the applicant's claim1. The Applicant respectfully disagrees.

More specifically, the Examiner seems to mistakenly equate the Applicant's "first and second device" (i.e., the respective Auto MDI device 1000 and the Auto MDI device 1050 in the end-to-end automatic MDI reconfigure and repair system in Fig. 10) to the two respective controllers 110 and 112, which are located within an individual Auto MDI device in Fig. 1 (i.e., the "APA"). In other words, each device represents an individual Auto MDI device instead of just a controller within an individual Auto MDI device. The Examiner also equates the two media pairs (i.e., media pair 1 and 2) coupled to the first controller 110 (i.e., the alleged "first device") to the Applicant's "all existing media pairs", where there are in fact, four media pairs (i.e., "all existing media pairs") within the individual Auto MDI device. In this regard, the APA discloses that the Auto MDI device (i.e., the first device) **only determines one usable media pair from two instead of all (four) existing media pairs**. Therefore, the Applicant maintains that the "APA" does not anticipate the Applicant's claim 1.

Nevertheless, for the sake of advancing prosecution, the Applicant has amended the claim language of claim 1 for clarification, where claim 1 now reads

"determining any one usable media pair from all existing media pairs of a first device; ... wherein **said first device communicates using at least three media pairs of said all existing media pairs**". The Applicant points out that the amendments are supported in at least Figs. 2 to 10. For example, the controller 1010 of the first Auto MDI device 1000 in Fig. 10 communicates to media pairs Pr1 to Pr4.

The Applicant submits that the amended claim 1 is further distinguished from the "APA", since the Examiner alleges that the controller 110 (i.e., the alleged "first device") in the "APA" determines from two media pairs (instead of at least three media pairs) as the alleged "all existing media pairs". The Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. 102(b) be withdrawn.

II. REJECTION UNDER 35 U.S.C. § 102

With regard to the anticipation rejections under 102, MPEP 2131 states that:

"[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

A. The Applicant's Background Section Does Not Anticipate Independent Claims 1, 11 and 21

The Applicant now turns to the rejection of independent claims 1, 11 and 21 under 35 U.S.C. 102(b) as being anticipated by APA.

A(1). Independent Claims 1, 11 and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. §102(b), the Applicant submits that APA does not disclose or suggest at least the limitation of "determining any one usable media pair from all existing media pairs of a first device;... wherein said first device communicates using at least three media pairs of said all existing media pairs", as recited in Applicant's claim 1.

The Final Office Action states that the above claim limitation is anticipated by APA as follows:

auto-MDIX reconfigure channels to properly reassign the media pairs to channels, therefore a usable media pair is determined from all existing media pairs. *See* Final Office Action at page 2.

The Examiner relies for support on the Applicant's paragraph [04], lines 1-6, which states:

In a typical 4-pair conductor or wire system, auto-MDIX may be adapted to automatically detect the order of media pairs 1 and 2 and in certain instances, auto-MDIX *may reconfigure only certain channels* so as to properly re-assign the transmit/receive media pairs to these channels. Auto-MDIX may also be adapted to reconfigure channel ordering for *certain channels* in order to mitigate the effects of improper interfacing and/or configuration. [Emphasis added].

See the Applicant's paragraph [04], lines 1-6. The Examiner mistakenly equates each of the two controllers 110, 112 shown in "APA" to Applicant's "first and second device". The Examiner also mistakenly equates the two media pairs (i.e., media pair 1 and 2) coupled to the first controller 110 (i.e., the alleged "first device") to Applicant's "all existing media pairs".

The Applicant has amended claim 1 to read "determining any one usable media pair from all existing media pairs of a first device;... wherein **said first device communicates using at least three media pairs of said all existing media pairs**".

The Applicant refers the Examiner to the Applicant's response in section I above, and submits that claim 1 is allowable and not anticipated by the "APA". The Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn.

Independent claims 11 and 21 are similar in many respects to independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1, 11 and 21.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

A. The Proposed Combination of "APA" and Bontemps Does Not Render Claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-30 Unpatentable

Claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-30 are rejected under 35 U.S.C. §103(a) over APA, in view of Bontemps.

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(b) as being anticipated by the "APA" has been overcome, and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20 and 22-30 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable. The Applicant maintains the arguments of the 10/31/08 reply to the Office Action to the above claims.

In addition, with regards to claims 2, 12, and 22, the applicant points out that the amendments "a corresponding second device with at least three media pairs" overcomes both the APA and Bontemps, which disclose only two media pairs. Claims 2, 12, and 22 are therefore submitted to be allowable.

Likewise, claims 3, 13, and 23 are submitted to be allowable based on dependency on claims 2, 12 and 23.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-5, 7-15, 17-25 and 27-30.

IV. Objection to Claims 6, 16 and 26

Claims 6, 16 and 26 are objected to as being dependent upon a rejected base claims. The Applicant has cancelled claims 6, 16 and 26, and rewritten claims 6, 16 and 26 into independent form as corresponding claims 31-33. The Applicant submits that claims 31-33 are in condition for allowance.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-5, 7-15, 17-25 and 27-33 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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